



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/688,131

10/17/2003

Clifford A. Oostman JR.

P5366.C2

2022

26253

7590

10/27/2005

DAVID W. HIGHET, VP AND CHIEF IP COUNSEL  
BECTON, DICKINSON AND COMPANY  
1 BECTON DRIVE, MC 110  
FRANKLIN LAKES, NJ 07417-1880

EXAMINER

HANNAHER, CONSTANTINE

ART UNIT

PAPER NUMBER

2884

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/688,131

Applicant(s)

OOSTMAN ET AL.

Examiner

Constantine Hannaher

Art Unit

2884

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-37, 43 and 45 is/are rejected.
- 7) ☒ Claim(s) 38-42 and 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20040226</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Priority**

1. The benefit claim filed on February 26, 2004 was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires the benefit under 35 U.S.C. 120 based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

### Information Disclosure Statement

2. The information disclosure statement filed February 26, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

U.S. patent application 09/853,043 matured into United States Patent No. 6,809,804.

### Specification

3. The disclosure is objected to because of the following informalities: the amendment filed February 26, 2004 is improper in the absence of a grantable petition of the type described above.

Appropriate correction is required.

### Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 35, 36, and 43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ortyn *et al.* (US20020071121A1).

With respect to independent claim 35, Ortyn *et al.* discloses a detector apparatus (Fig. 28) for analyzing light emitted from a fluorescent material (at object plane 348) wherein the light is gathered by a light collector 48 and formed into an output beam by slit 52 (see discussion below), comprising a means 32 for collimating the output beam from object plane 348, the collimated output beam having a projected optical axis, and a plurality of dichroic mirrors 301, 302, 303 disposed along the

projected optical axis in a manner as recited. Two out of three dichroic mirrors in the detector apparatus of Ortyn *et al.* receive light reflected from another dichroic mirror, thus a majority. See paragraph [0082] for analysis of fluorescent material using light sources 60a, 60b, 62, and 64. Fig. 26 shows a light collector identified as 52 and a slit identified as 48, paragraph [0127] reverses the reference symbols (as used above) and explicitly discloses the inclusion of the lens and the slit in the embodiment of Fig. 28.

With respect to dependent claim 36, all of the dichroic mirrors except one in the detector apparatus of Ortyn *et al.* receive light reflected from a dichroic mirror (only dichroic mirror 301 does not while 302 received the reflected beam from 301 and 303 receives the reflected beam from 302).

With respect to dependent claim 43, the dichroic mirrors in the detector apparatus of Ortyn *et al.* are arranged such that the transfer legs follow a zigzag pattern (Fig. 28).

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made

in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 37 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortyn *et al.* (US20020071121A1).

With respect to dependent claim 37, although the embodiment of the detector apparatus of Ortyn *et al.* illustrated in Fig. 28 shows three dichroic mirrors serving four detectors, there are five detectors in the embodiment of Fig. 25. If there are five wavelengths or wavelength ranges to be detected as suggested by the embodiment of Fig. 25, and the placement of detectors in the transmission path of the dichroic filters as shown in Fig. 28 is desired, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the embodiment of Fig. 28 to include at least a fourth dichroic mirror in the reflection path of 303 such that a fifth detector could be placed in its reflection path (as detector 322 would be in the transmission path of such a fourth filter).

With respect to dependent claim 45, the choice of detectors 321-324 in the detector apparatus of Ortyn *et al.* is one within the ordinary skill in the art as one or more of the recited types are suggested in paragraph [0075].

#### **Response to Submission(s)**

9. The amendment to the claims filed February 26, 2004 has been entered.

10. This application has been published as US2005/0104008A1 on May 19, 2005.

#### **Allowable Subject Matter**

11. Claims 38-42 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: in combination with the detector apparatus as recited, the angles, patterns, and fiber reception recited are not suggested.

**Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (571) 272-2437. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ch

  
Constantine Hannaher  
Primary Examiner